

Remarks

Claims 1-11, 20-30, 48, 50, and 51 are pending in the application. Claims 12-19, 31-47, and 49 have been canceled without prejudice as being drawn to a non-elected invention. Claims 1, 5, 6, 20, 24, 25, and 48 have been amended. New claims 50 and 51 have been added. Support for the claim amendments and new claims can be found throughout the application. Therefore, no new matter has been added. Further, the Applicants expressly reserve the right to prosecute the canceled claims in one or more divisional applications claiming the benefit of priority to the instant application and its predecessor(s). 35 USC § 121.

Importantly, the claim cancellations and amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, the cancellations of and amendments to the claims are being made solely to expedite the prosecution of the above-identified application. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Claim Rejections Based on 35 USC § 112¶1

Claims 1-11, 20-30, and 48 were rejected under 35 USC § 112¶1, based on the Examiner's contention that various claim terms do not comply with the written description requirement. Further, the Examiner states that "although specific claims are referenced in the rejections set forth below, these rejections are also applicable to all other claims in which the noted problem/language occur." To better organize the Applicant's traverses of the Examiner's rejections under 35 USC § 112¶1, they are set forth below in paragraphs labeled according to the format used in the Office Action.

Claim Rejection 4a.

The Examiner contends that the generic definition of "V" in claim 1 is not supported by the written description. In order to expedite prosecution, the Applicants have amended claim 1 to insert a new definition for "V." Support for the Markush group variables "amino, amido...sulfinyl" can be found in the second paragraph on page 34 of the application. Support

for the limitation that “V” is heterocyclyl can be found in the definition of “V” near the end of the first paragraph on page 35 which reads “...heterocyclic compounds, including pyridine and the like.” In light of the amendment to the definition of “V” in claim 1, the Applicants amended claims 5 and 6 so that “V” is amino. As noted above, support for the limitation that “V” is amino can be found in the second paragraph on page 34 of the application as filed.

The definition of “V” in claims 20, 24, 25, and 48 was amended as described above for claims 1, 5, and 6 because the Examiner has stated that the rejections of claim 1 are applicable to all other claims in which the noted problem/language occurs.

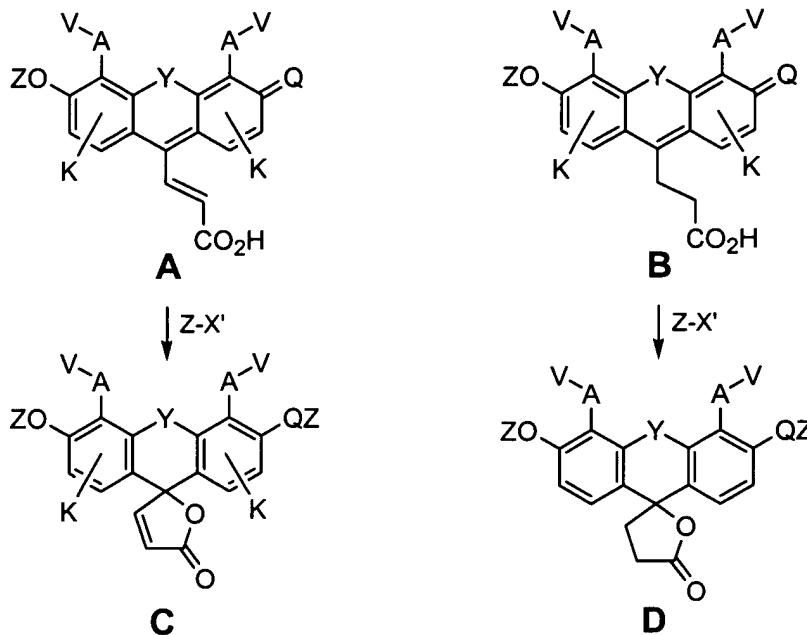
Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

Claim Rejection 4b.

The Examiner contends that variable “D” as defined in Formula III is not supported by the written description. In addition, the Examiner states that the Applicant’s previous comments in the communication dated “March 11, 2004” relate to “the lactone and free acid forms of fluorescein but the newly presented -CH₂CH₂- and -CH=CH- definitions of ‘D’ do not relate to the lactone/free acid forms of fluorescein.” The Applicants respectfully disagree. Incidentally, the Applicants note that their previous communication contained a properly executed Certificate of Mailing dated March 8, 2004.

The Applicants point out that the definition of Z2 on page 31 of the application includes “-HOOCCH₂CH₂C-” and “-HOOCCH=CHC-.” Therefore, formula 2A on page 31 of the application describes structures represented by **A** and **B** presented below. As described on pages 30-31 in the application and on pages 25-27 in Applicants’ communication dated March 8, 2004, the free acid form may convert to the lactone form under certain conditions. The lactone form is represented by **C** and **D** presented below. Importantly, variables “-CH₂CH₂-” and “-CH=CH-” in the definition of “D” in claim 1 are *not* new matter because they are part of variables “-HOOCCH₂CH₂C-” and “-HOOCCH=CHC-” recited in the definition of Z2 on page 31 of the application. Moreover, the application states on pages 30-31 that the free acid form can convert to the lactone form. Variables “-CH₂CH₂-” and “-CH=CH-” in the definition of “D” merely represent the remainder of the γ -lactone ring presented in **C** and **D** below which is not depicted in formula III in claims 1 and 48. Consequently, the Applicants contend that the application

contains sufficient written support for variables “-CH₂CH₂-” and “-CH=CH-” in the definition of “D” in claims 1 and 48 as it relates to formula III.



The Applicants also point out that the above arguments apply to the definition of “D” in claim 20 and to formula VI in claim 48 because the definition of Z2 on page 31 of the application also applies to formula 1A on page 31 of the application. Therefore, the Applicants contend that the application contains sufficient written support for variables “-CH₂CH₂-” and “-CH=CH-” in the definition of “D” in claims 20 and 48.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

Claim Rejection 4c(i).

The Examiner contends that no support can be found in the specification for -CH₂C(=O)-, -CH₂C(=S)-, and -C(H)= in the definition of variable “A” in claim 1. Furthermore, the Examiner contends there is no support for the phrase “with the hydrogen atoms optionally substituted” in the definition of variable “A” in claim 1.

In order to expedite prosecution, the Applicants have amended the definition of variable “A” in claim 1 to remove the phrase “with the hydrogen atoms optionally substituted.” In addition, the Applicants have amended the definition of variable “A” in claim 1 to remove “-C(H)=” in the definition of variable “A.”

However, the Applicants contend that the specification contains sufficient written support for $\text{-CH}_2\text{C(=O)-}$ and $\text{-CH}_2\text{C(=S)-}$ in the definition of variable “A” in claim 1. Support for the limitation that “A” is $\text{-CH}_2\text{C(=O)-}$ or $\text{-CH}_2\text{C(=S)-}$ can be found in the first paragraph on page 32 of the application as filed. The specification states that “A is -C(=O)- , -C(=S)- , or CHJ... or $\text{-CH}_2\text{D-}$, -CHJD- , or $\text{-CJ}_2\text{D-}$, etc. where D is any of the foregoing moieties.” Hence, $\text{-CH}_2\text{C(=O)-}$ is supported by the recitation of “ $\text{-CH}_2\text{D-}$ ” wherein D is “ -C(=O)- ” which is one of the foregoing moieties referred to in the definition of “A” in the specification. Likewise, $\text{-CH}_2\text{C(=S)-}$ is supported by the recitation of “ $\text{-CH}_2\text{D-}$ ” wherein D is “ -C(=S)- ” which is one of the foregoing moieties referred to in the definition of “A.”

The definition of variable “A” in claims 20 and 48 was amended as described above for claim 1 because the Examiner has stated that the rejections of claim 1 are applicable to all other claims in which the noted problem/language occurs. As described above, support for the fact that “A” can be $\text{-CH}_2\text{C(=O)-}$ or $\text{-CH}_2\text{C(=S)-}$ can be found in the first paragraph on page 32 of the application as filed.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

Claim Rejection 4c(ii).

The Examiner contends there is no support in the specification for aliphatic, aralkyl, aryl, amido, sulfonate, sulfate, sulfamyl, sulfoxido, and selenoalkyl in the definition of variables “K” and “E” in claim 1. In order to expedite prosecution, the Applicants have amended claim 1 to remove aliphatic, aralkyl, aryl, amido, sulfonate, sulfate, sulfamyl, sulfoxido, and selenoalkyl in the definition of variables “K” and “E.”

The definition of variables “K” and “E” in claims 20 and 48 were amended as described above for claim 1 because the Examiner has stated that the rejections of claim 1 are applicable to all other claims in which the noted problem/language occurs.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

Claim Rejection 4c(iii).

The Examiner contends there is no support in the specification for the phrase “said phenyl moiety is optionally substituted with one or more E.” The Applicants respectfully disagree.

The Applicants respectfully direct the Examiner to formula 3 on page 37 of the application which has variable K attached to the phenyl group. This illustration provides sufficient support for the limitation of claim 1 that the phenyl moiety is optionally substituted with one or more E. The Applicants point out that all of the members of the Markush group of variable E in amended claim 1 are sufficiently described by the definition of variable K described on pages 32 and 33 of the application. *Critically, the Applicants respectfully assert that the mere fact that overlapping subject matter was abbreviated with different capital letters in different sections of the application does not negative the sufficiency of the written description provided by the application.*

Regarding claim 20, the Applicants point out that sufficient support for the fact that the phenyl moiety is optionally substituted with one or more E can be found page 37 of the application as filed. Specifically, the Applicants direct the Examiner to formula 4 on page 37 of the application which has variable K attached to the phenyl group. The Applicants point out that all of the members of the Markush group of variable E in amended claim 20 are sufficiently described by the definition of variable K described on pages 32 and 33 of the application. Finally, Applicants’ arguments regarding support for the limitation that the phenyl moiety is optionally substituted with one or more E in relation to claims 1 and 20 apply to claim 48.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

Claim Rejection 4c(iv).

The Examiner contends there is no support in the specification for the phrase “said carbonyls are optionally a carbonyl other than carboxylic acid.” In order to expedite prosecution, the Applicants have amended the definition of Z2 in claim 1 to remove the phrase “said carbonyls are optionally a carbonyl other than carboxylic acid.”

Claims 20 and 48 were amended as described above for claim 1 because the Examiner has stated that the rejections of claim 1 are applicable to all other claims in which the noted problem/language occurs.

Accordingly, the Applicants respectfully request withdrawal of the rejections based on 35 USC § 112¶1.

New Claims

The Applicants have added new dependent claims 50 and 51. The general formula in claims 50 and 51 is displayed as formula 5 and formula 6, respectively, on page 37. The definition of R¹ can be found in the last full paragraph on page 37. The definition of K can be found on page 32 of the application as filed. Therefore, newly added claims 50 and 51 have sufficient written support in the application as filed.

Conclusion

In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. Therefore, the Applicants respectfully request reconsideration and withdrawal of the pending rejections. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned.

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Respectfully submitted,
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